

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,889	01/18/2002	Emil A. Tanagho	02307E-080710US	3329
20200	7590 03/23/200 AND TOWNSEND AN	EXAMINER		
TWO EMBARO	CADERO CENTER	PREBILIC, PAUL B		
EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834  ART UNIT				PAPER NUMBER
	,		3738	
		•		·
SHORTENED STATUTORY	Y PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE	
3 MON	NTHS	03/23/2007	PAF	PER

# Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

				~
		Application No.	Applicant(s)	
	Office Action Comments	10/052,889	TANAGHO ET AL.	
	Office Action Summary	Examiner	Art Unit	
		Paul B. Prebilic	3738	
Period fo	The MAILING DATE of this communic	cation appears on the cover sheet	with the correspondence address -	•
A SHI WHIC - Exter after - If NO - Failu Any r	ORTENED STATUTORY PERIOD FOR CHEVER IS LONGER, FROM THE MAN INSIGNS OF time may be available under the provisions of SIX (6) MONTHS from the mailing date of this community period for reply is specified above, the maximum state to reply within the set or extended period for reply very received by the Office later than three months after the patent term adjustment. See 37 CFR 1.704(b).	AILING DATE OF THIS COMMUI of 37 CFR 1.136(a). In no event, however, may unication. tutory period will apply and will expire SIX (6) M will, by statute, cause the application to become	NICATION. a reply be timely filed  ONTHS from the mailing date of this communica ABANDONED (35 U.S.C. § 133).	
Status				
2a)☐	Responsive to communication(s) filed This action is <b>FINAL</b> . 2 Since this application is in condition for closed in accordance with the practice.	b) This action is non-final.  or allowance except for formal management		is
Dispositi	on of Claims			
5) □ 6) ⊠ 7) □ 8) □ <b>Applicat</b> i 9) □ 10) □	Claim(s) 24-28 is/are pending in the adaptive day of the above claim(s) is/are Claim(s) is/are allowed.  Claim(s) 24-28 is/are rejected.  Claim(s) is/are objected to.  Claim(s) are subject to restrict from Papers  The specification is objected to by the The drawing(s) filed on is/are:  Applicant may not request that any object Replacement drawing sheet(s) including The oath or declaration is objected to	e withdrawn from consideration.  tion and/or election requirement.  Examiner.  a) accepted or b) objected or b beld in abey the correction is required if the drawing of th	vance. See 37 CFR 1.85(a). ng(s) is objected to. See 37 CFR 1.12	
Priority ι	ınder 35 U.S.C. § 119			
a)	<ul><li>2. Certified copies of the priority of</li><li>3. Copies of the certified copies of</li></ul>	documents have been received. documents have been received ir of the priority documents have be nal Bureau (PCT Rule 17.2(a)).	Application No en received in this National Stage	
2) Notice 3) Information	te of References Cited (PTO-892) te of Draftsperson's Patent Drawing Review (Pmation Disclosure Statement(s) (PTO/SB/08) or No(s)/Mail Date	TO-948) Paper N	w Summary (PTO-413) lo(s)/Mail Date of Informal Patent Application	

Application/Control Number: 10/052,889

Art Unit: 3738

### **Prosecution Reopened**

Page 2

In view of the Appeal Brief filed on December 4, 2006, PROSECUTION IS

HEREBY REOPENED. A new ground is set forth below. A telephone interview was

conducted with Chuan Gao on March 12, 2007 to request that a terminal disclaimer and

corrected 37 CFR 1.132 attribution declaration be filed. However, although Chuan Gao

attempted to file these items expeditiously, there was insufficient time left in the

response period to have them entered and processed.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

CORRINE MCDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Art Unit: 3738

#### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 8, and 10 of U.S.

Patent No. 6,371,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are so similar that they are considered obvious over each other. This is due to the fact that the bladder (patented claims) and the ureter or urethra as presently claim, are from the same tract and connected to each other. For this reason, it would have been obvious to make a matrix from one or the other because of their similarity in structure and function.

#### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Application/Control Number: 10/052,889

Art Unit: 3738

Claims 24 to 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Probst et al (article entitled "Reproduction of functional smooth muscle tissue and partial bladder replacement") alone. Probst discloses making an insoluble matrix of elastin and collagen but utilizing bladder tissue and not ureter or urethra tissue as claimed. However, since bladder tissue (as in Probst) and ureter or urethra tissue (as presently claimed), are from the same tract and connected to each other (i.e. both are in regular contact with urine), it is the Examiner's position that it would have been obvious to an ordinary artisan to utilize ureter or urethra tissue to make an insoluble elastic matrix graft in order to repair the corresponding structure for the same reasons that Probst utilizes a matrix derived from bladder tissue to repair the bladder.

The previously submitted declaration filed July 27, 2004 was found to be insufficient in that it referred to the parent serial number rather than the present serial number and it stated the "we two are co-inventors" (3<sup>rd</sup> paragraph) when there are actually four inventors.

## Response to Arguments

Applicant's arguments with respect to claims 24 to 28 have been considered but are most in view of the new ground(s) of rejection. The previous prior art rejections have been withdrawn as a result of Applicant's arguments, but a new ground was necessitated by the insufficient 37 CFR 1.132 previously filed.

#### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited prior art was made of record and considered

Art Unit: 3738

previously, but not entered into the file electronically. For this reason, the prior art is recited as a means to have it available electronically.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Prebilic Primary Examiner

Art Unit 3738